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REMARKS

Claims 23-28, 30-35, and 37-38, and 40-45 are currently pending in the subject application and are presently under consideration. Claims 23-28, 30, 38, 40, and 43 have been amended as shown on pp. 2-6 of the Reply. Claims 24-28, 30, and 40 have been amended herein to correct minor informalities. Applicants' representative acknowledges with appreciation the Examiner's indication that claims 39 and 45 would be allowable if rewritten in independent form to recite limitations of respective base claims and any intervening claims. As such, claim 39 has been cancelled and the allowable subject matter has been incorporated into independent claim 38. It is believed that amended independent claim 23, from which claim 45 depends, is allowable with regard to Bianco in view of PC EXPO. Thus, claim 45 has not been amended. However, applicants' representative reserves the right to amend claim 45 should a need arise in future prosecution. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 23-24, 31-35, and 37 Under 35 U.S.C. §101

Claims 23-24, 31-35, and 37 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The subject claims produce a useful, concrete, and tangible result.

Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 citing *In*

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re Alappat, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (Emphasis added) (holding that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display).

Independent claim 23 has been amended herein to further emphasize the useful, concrete, and tangible result produced. For example, independent claim 23 recites generating a list of desired items at a location remote from the shopping facility, transmitting the list via an e-mail to a first computer, storing the list in a user data file on the first computer and associating the list with previous lists in the user data file, retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, and delivering the list to the user at the shopping facility in a user perceptible format.

The invention as recited in the subject claims produces a useful, concrete, and tangible result. More particularly, the subject claims recite a method to generate a shopping list at a remote location, store the list on a central host, incorporate the list into the shopper's file, and retrieve the list at a later time at the shopping facility. Thus, the user at his convenience is able to generate and store lists of items to be purchased and will later be supplied with a comprehensive list at the shopping facility when it is convenient to shop. As such, the subject invention teaches a useful, concrete, and tangible result because it provides a convenience/service that improves the shopping process by delivery of a list of desired items to the user at the shopping facility in a user perceptible format.

In view of the above, it is readily apparent that the claimed invention produces a useful, concrete, tangible result. Therefore, pursuant to *AT&T Corp v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed.Cir. 1999), the subject claims are directed to statutory subject matter pursuant to 35 U.S.C. §101. Accordingly, this rejection should be withdrawn.

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II. Rejection of Claims 30 and 40-42 Under 35 U.S.C. §102(b)

Claims 30 and 40-42 stand rejected under 35 U.S.C. §102(b) as being anticipated by Roach *et al.* (U.S. 5,310,997). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Roach *et al.* does not teach or suggest *each and every element* of the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

The subject invention relates to an improved shopping facility where a user can remotely generate lists, incorporate and store the lists on a shopping facility host computer, retrieve the list upon arrival at the facility, and use a portable terminal to assist in shopping. In particular, amended independent claim 30 (and similarly amended independent claim 40) recites a *shopping list distribution communication device* that delivers the *customer list presented on the kiosk* to the *portable terminal* corresponding to the customer using the self-scanning system. Roach *et al.* relates to a system for processing merchandise sale transactions using pen-based sale transaction computers communicating customer and merchandise information to a main processor via RF transmissions. (See Abstract). However, Roach *et al.* is silent with regard to a *shopping list distribution communication device*. Additionally, Roach *et al.* does not teach or suggest a *customer list presented on the kiosk*. Instead, Roach *et al.* describes that the kiosk is used for scanning entry membership cards. (See col. 8, ll 7-12). Moreover, Roach *et al.* does not teach or suggest delivery of the customer list to the *portable terminal*. Rather, the portable terminal is used for outgoing communication to make purchase selections and read member cards and label codes. (See col. 5, ll. 47-50). As such, Roach *et al.* does not teach or suggest *each and every element* of the subject invention as claimed.

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The alleged functional limitations in the subject claims should not be dismissed by the examiner when considering *each and every element* of the claimed invention. In the Office Action dated March 1, 2005, the Examiner contends that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). (See page 5). Applicants' representative respectfully disagrees with application of such a broad statement with regard to the subject invention. First, with regard to system claims there is ample precedent to establish that functional limitations should be afforded patentable weight by the Examiner for determining anticipation. (See e.g., *In re Ludtke*, 441 F. 2d 660, 169 USPQ 563, 566 (C.C.P.A. 1971). Second, in *In re Danly*, claims 1 and 2 were rejected *but claims 3-7 were allowed*. Even though the structure recited in each claim was substantially similar to the prior art, claims 3-7 were construed to limit performance of the apparatus to a novel function as were thus allowed. (See *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, ___ (CCPA 1959).

The Examiner further contends that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim, *Ex parte Masham* 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). (See page 5). Applicants' representative respectfully disagrees with the application of the statement to the subject invention with regard to Roach *et al*. Application of the statement necessitates the prior art apparatus teaching all the structural limitations of the claim. For example, in *Ex parte Masham* the subject claim was rejected because each and every element read upon prior art. (See *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Additionally, the prior art apparatus enjoyed the same functionality as that claimed, as both were mixers. (See *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). The argument that failed was that the claim overcame rejection because the mixing means of the claimed apparatus was "completely submerged" rather than "partially submerged" as depicted in the prior art. (See *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Recognizing the same structure and the same function, the court stated that "the apparatus disclosed...does not undergo a metamorphosis to a *new apparatus* merely by indicating that a sufficient amount of ...

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material may be poured into the apparatus to completely submerge the ... mixing means. (See *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

The invention as recited in the subject claims discloses both a new apparatus and an apparatus with a novel function with regard to Roach *et al.* With regard to *Ex parte Masham*, the subject invention and the invention taught by Roach *et al.* are not merely two of the same shopping facilities. As discussed *supra*, the claims when taken as a whole recite a new apparatus with different structure and novelty not disclosed in Roach *et al.* Additionally, even if the Examiner's assertion that Roach *et al.* recites the same structure as disclosed in the subject invention is accepted, independent claims 30 and 40 limit the subject invention to the performance of a novel function and would be allowable under *In re Danly*.

Furthermore, in the Office Action dated November 10, 2003, Examiner conceded that Bianco in view of Roach *et al.* does not specifically disclose a **shopping list distribution communication device** for delivering the **customer list presented on the kiosk** to the **portable terminal** corresponding to the customer using the self scanning system as recited in independent claim 30. (See pg. 3). The examiner also conceded that Bianco in view of Roach *et al.* does not specifically disclose a messaging system for receiving an electronic message generated by a customer, and at least one **kiosk for generating a list of items** to be purchased, the kiosk in communication with the messaging communication system such that the list is generated based upon the message received from the customer as recited in independent claim 40. (See pg. 3). Since Bianco in view of Roach *et al.* does not specifically disclose each and every element of the subject invention, Roach *et al.* alone does not accomplish that task. Accordingly, the rejection should be withdrawn.

In view of at least the foregoing, it is readily apparent that Roach *et al.* does not teach or suggest *each and every element* of the subject invention as recited in independent claims 30 and 40 (and claims 41-42 which depend there from). Accordingly, this rejection should be withdrawn.

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III. Rejection of Claims 23-24, 27-28, 35-36, 38, and 43-44 Under 35 U.S.C.**§103(a)**

Claims 23-24, 27-28, 35-36, 38, and 43-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco (U.S. 6,047,614) in view of PC EXPO. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Bianco and PC EXPO, either alone or in combination, do not teach or suggest all the limitations recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Bianco and PC EXPO, alone or in combination, fail to teach or suggest storing the list in a *user data file stored on the first computer and associating the list with previous lists* in the user data file, and *retrieving the list at the shopping facility* from the user data file *using a kiosk* which communicates with the first computer as recited in independent claim 23 (and similarly in independent claims 38 and 43).

More particularly, Bianco does not teach or suggest *retrieving the list* from a *user data file stored on the first computer* using a *kiosk* and *associating the list with previous lists*. Bianco relates to a home bar code scanning system that is used to compose a shopping list by scanning bar codes of products, pamphlets, and coupons in a remote location. (See col. 3, ll. 14-44). To obtain the shopping list, the home scanning system must be transported to a shopping facility or the information must be transmitted via telephone modem. (See cols. 3-4 ll. 44-40). In the Office Action dated November 11,

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2003, the Examiner concedes that Bianco, in view of Roach *et al.* does not disclose or fairly teach transmitting the list via an email to a first computer and retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer. Specifically, Bianco does not retrieve the list from a *user data file* stored *on the first computer* as disclosed in the subject invention. Bianco instead retrieves the list that is *stored in a bar code reading terminal*. (See col. 3, ll. 50-57). Furthermore Bianco is silent with regard to the modem transmitted list being retrieved from the first computer at a kiosk at the shopping facility and associating the list with previous lists in the user data file. Since Bianco is silent with regard to *retrieving the list* from a *user data file* stored *on the first computer* using a *kiosk* at the shopping facility and *associating the list with previous lists*, it fails to teach or suggest such claimed aspects.

PC EXPO fails to make up for the aforementioned deficiencies of Bianco with respect to the subject invention because it does not teach or suggest *retrieving the list* from a *user data file* stored *on the first computer* using a *kiosk* and *associating the list with previous lists* in the user data file. PC EXPO describes a plan to transform Singapore into an intelligent island by linking commercial, government, and other major networks in the country. The article notes that checking email at a kiosk is a convenient form of communication. However, PC EXPO is not relevant to the aspects of *shopping* disclosed by the subject invention. More particularly, PC EXPO is silent with regard to *retrieving the list from a kiosk* at the shopping facility, a *user data file* stored on a first computer, and *associating the list with previous lists* in the user data file. As such, PC EXPO does not make up for the aforementioned deficiencies in Bianco.

Additionally, the allowable subject matter previously recited in claim 39 has been incorporated into amended independent claim 38. Thus, Bianco and PC EXPO, either alone or in combination, do not teach or suggest the subject invention. Accordingly, this rejection should be withdrawn.

In view of at least the foregoing, it is readily apparent that Bianco and PC EXPO, either alone or in combination, do not teach or suggest the subject invention as recited in independent claims 23, 38, and 43 (and dependent claims 24, 27-28, 35-36, and 44 which directly or indirectly depend there from). Accordingly, this rejection should be withdrawn.

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IV. Rejection of Claims 25-26 Under 35 U.S.C. §103(a)

Claims 25-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco (U.S. 6,047,614) in view of PC EXPO further in view of Roach *et al.* (U.S. 6,310,977). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Independent claim 23, from which claims 25 and 26 depend, has been amended such that Bianco, PC EXPO, and Roach *et al.*, either alone or in combination, do not teach or suggest each and every element of the subject claim. In particular, Roach *et al.* fails to make up for the aforementioned deficiencies of Bianco and PC EXPO with regard to amended independent claim 23. Accordingly, this rejection should be withdrawn.

V. Rejection of Claims 31-33, and 37 Under 35 U.S.C. §103(a)

Claims 31-33 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco (U.S. 6,047,614) in view of PC EXPO further in view of Gordon (U.S. 5,608,786). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Independent claim 23, from which claims 31-33 and 37 directly and indirectly depend, has been amended such that Bianco, PC EXPO, and Gordon, either alone or in combination, do not teach or suggest each and every element of the subject claim. In particular, Gordon fails to make up for the aforementioned deficiencies of Bianco and PC EXPO with regard to amended independent claim 23. Accordingly, this rejection should be withdrawn.

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CONCLUSION

The subject application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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